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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,527	12/02/2005	Mitsutoshi Shinkai	SON-3029	2726
23353 7590 07/07/2009 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER YODICHKAS, ANEETA				
ART UNIT		PAPER NUMBER		
2627				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,527

**Applicant(s)**

SHINKAI ET AL.

**Examiner**

Aneeta Yodichkas

**Art Unit**

2627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/28/09 has been entered.

### ***Claim Objections***

2. Claim 7 is objected to because of the following informalities: Claim 7 depends on cancelled claim 6. It is assumed that Applicant wanted claim 7 to depend on independent claim 1 as a result of cancelling claim 6. Appropriate correction is required.
3. Claim 12 is objected to because of the following informalities: It is stated that the claim is currently amended, but there is no underlining showing the amended portions of the claims. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim 12** is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Pub. No. 2002/0097645 A1 to *Mikawa*.

As to **claim 12**, *Mikawa* discloses a recording medium having recorded thereon data that is played back by an information processing apparatus that manages data wherein a first file including an identifier for identifying a format on the recording medium, the first file serving to manage data in the format, and a second file including an identifier that is the same as the identifier, the second file further including label information describing content of data in the format, are recorded in the format as mutually different files (Fig. 2 and 3, paragraphs 0062-0070, 0076), where the identifier is the copy management processor (207) which is the same for the first and second files or discs (D1, D2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 7-11 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0097645 A1 to *Mikawa* in view of U.S. Patent No. 6,937,553 B1 to *Mitui et al.*

As to **claim 1**, *Mikawa* discloses an information processing apparatus for managing data that is recorded on a recording medium, the information processing apparatus comprising: copying means for copying an identifier for identifying a format

that is managed by a first file for managing information recorded on the recording medium, the identifier being included in the first file (Fig. 2 and 3, paragraph 0076,), where the copy management processor (207) provides the copying means for copying content identification information and the first file is disc 1 (D1); creating means for creating a second file including the identifier copied by the copying means and label information describing content of the data further comprising a setting means for setting the label information (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information; wherein the creating means creates the second file including the identifier copied by the copying means and the label information set by the setting means (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information, and wherein said label information includes information regarding a representative frame image representing all the frame images of image data included in the recording medium (Fig. 7, paragraph 0087), where the file management information is the label which includes the information representative of the frames; and recording means for recording the second file created by the creating means in the format on the recording medium, as a file that is different from the first file (Fig. 2, paragraphs 78-79 and 85); and a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium (Fig. 4 and 5, paragraph 0110), where database management unit (405)

compares the update TOD information of the disk management information with the update TOD information read from the disk D.

*Mikawa* is deficient in disclosing wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file.

However, *Mitui* discloses the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file (Fig. 14, column 12, lines 48-55, column 13, lines 3-7), where the embedded medium ID information is compared with the medium ID information and if they are matched, then recording is performed.

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to have modified the information processing apparatus for managing data that is recorded on a recording medium as taught by *Mikawa* by including recording a second file only when it is determined that the second file matches with the identifier of the first file as taught by *Mitui*. The suggestion/motivation would have been in order to insure that both discs formats are of the same type from the same region before performing recording (Fig. 14, column 12, lines 43-55).

As to **claim 7**, *Mikawa* discloses the information processing apparatus comprising: reading means for reading the second file from the recording medium (Fig. 6 and Fig. 7, paragraphs 106-107); and updating means for updating the label

information included in the second file read by the reading means (Fig. 2, paragraph 47); wherein the comparing means compares an identifier included in the second file whose label information has been updated by the updating means with an identifier included in the first file recorded on the recording means (Fig. 4 and Fig. 7, paragraphs 96-99), and wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file coincides with the identifier included in the first file (Fig. 4 and Fig. 7, paragraphs 96-99).

As to **claim 8**, *Mikawa* discloses the information processing apparatus wherein the recording medium is an optical disc (Paragraph 140).

As to **claim 9**, *Mikawa* discloses the information processing apparatus wherein the recording medium is a semiconductor memory (Paragraph 140).

As to **claim 10**, *Mikawa* discloses an information processing method for an information processing apparatus that manages data that is recorded on a recording medium, the information processing method comprising: a copying step of copying an identifier for identifying a format that is managed by a first file for managing information recorded on the recording medium, the identifier being included in the first file (Fig. 3, paragraphs 62-70); a creating step of creating a second file including the identifier copied by processing in the copying step and label information describing content of the data, further comprising a setting step for setting the label information (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information; wherein

the creating step creates the second file including the identifier copied by the copying step and the label information set by the setting step (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information, and wherein said label information includes information regarding a representative frame image representing all the frame images of the image data included in the recording medium (Fig. 7, paragraph 0087), where the file management information is the label which includes the information representative of the frames; and a recording controlling step of exercising control so that the second file created by processing in the creating step is recorded in the format on the recording medium, as a file that is different from the first file (Fig. 2, paragraphs 78-79 and 85); and a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium (Fig. 4 and 5, paragraph 0110), where database management unit (405) compares the update TOD information of the disk management information with the update TOD information read from the disk D.

*Mikawa* is deficient in disclosing wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file.

However, *Mitui* discloses wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file



matches with the identifier included in the first file (Fig. 14, column 12, lines 48-55, column 13, lines 3-7), where the embedded medium ID information is compared with the medium ID information and if they are matched, then recording is performed. In addition, the same motivation is used as the rejection in claim 1.

As to **claim 11**, *Mikawa* discloses a program for allowing a computer to execute processing for managing data that is recorded on a recording medium, the processing comprising: a copying step of copying an identifier for identifying a format that is managed by a first file for managing information recorded on the recording medium, the identifier being included in the first file (Fig. 3, paragraphs 62-70); a creating step of creating a second file including the identifier copied by processing in the copying step and label information describing content of the data, further comprising a setting step for setting the label information (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information; wherein the creating step creates the second file including the identifier copied by the copying step and the label information set by the setting step (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information, and wherein said label information includes information regarding a representative frame image representing all the frame images of the image data included in the recording medium (Fig. 7, paragraph 0087), where the file management information is the label which includes the information representative of the frames; and a recording controlling step of exercising control so that the second file created by

processing in the creating step is recorded in the format on the recording medium, as a file that is different from the first file (Fig. 2, paragraph 78-79 and 85); and a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium (Fig. 4 and 5, paragraph 0110), where database management unit (405) compares the update TOD information of the disk management information with the update TOD information read from the disk D.

*Mikawa* is deficient in disclosing wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file.

However, *Mitui* discloses wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file (Fig. 14, column 12, lines 48-55, column 13, lines 3-7), where the embedded medium ID information is compared with the medium ID information and if they are matched, then recording is performed. In addition, the same motivation is used as the rejection in claim 1.

As to **claim 13**, *Mikawa* discloses the information processing apparatus, wherein the first file includes both an identifier and a table including clip information and edit information (Fig. 6 and 7, paragraphs 0086-0087), where the file is the file management information and it includes a list or table of clip or file type, name, path, size and time information.

3. **Claims 4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0097645 A1 to *Mikawa* in view of U.S. Patent No. 6,937,553 B1 to *Mitui et al.* in further view of U.S. Patent Pub. No. 2002/0154898 A1 to *Hisatomi et al.*

As to **claim 4**, *Mikawa* and *Mitui* are deficient in disclosing the information processing apparatus wherein the setting means selectively sets the representative frame image from representative frame images of respective clips recorded on the recording medium.

However, *Hisatomi* discloses the information processing apparatus wherein the setting means selectively sets the representative frame image from representative frame images of respective clips recorded on the recording medium (Fig. 3, paragraph 65).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to have created an information processing apparatus for managing data that is recorded on a recording medium as taught by *Mikawa* and *Mitui* by including that it has a creating means for creating a second file and a setting means for selecting sets for the representative frame image as taught by *Hisatomi*. The suggestion/motivation would have been in order to be able to search or edit an image easily as taught by *Hisatomi* (*Hisatomi*, paragraph 65).

As to **claim 5**, *Mikawa* and *Mitui* are deficient in disclosing the setting means sets a beginning frame image of a beginning clip as the representative frame image when no instruction for setting the representative frame image is given

However, *Hisatomi* discloses the setting means sets a beginning frame image of a beginning clip as the representative frame image when no instruction for setting the representative frame image is given (Fig. 3, paragraph 63-64). In addition, the same motivation is used as the rejection for claim 4.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 10, 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aneeta Yodichkas whose telephone number is (571) 272-9773. The examiner can normally be reached on Monday-Thursday 8-5, alternating Fridays, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge L Ortiz-Criado/  
Primary Examiner, Art Unit 2627

/A.Y./  
6/30/09